

REMARKS

Claim Disposition

Claims 1-53, and 56-68 are pending. The Office Action further indicates that claims 9-22, 25-41, 56-58, and 66-68 have been withdrawn from consideration as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 2, 9-21, 44, 46-47, and 54-59 are cancelled without prejudice or disclaimer, applicant hereby reserving the right to file continuing applications or take any other such appropriate measure to prosecute the subject matter of the cancelled claims.

Claims 1, 3, 22, 24, 26, 33, 34, 45, 48, 60, 63, 66, 67, and 68 are amended as further explained below, and new claims 69-73 are added.

Claims 1, 3, 4, 8, 22 to 43, 45, 48 to 53, and 60-73 will be pending in the application upon entry of this amendment.

No new matter is entered by way of this submission.

Support for claim amendments

The claim amendments set forth above are supported by the original specification and claims, and as further explained below.

The structural formulas presented in claims 1, 3, 26, and 60 are amended to further depict the stereochemistry of the indicated position set forth in the amended claims; the amendment supported, for example, by the specification page 68, lines 8-13. The claims under consideration are further amended to designate the amended structural formulas as "I'" (Claims 1 and 26); "Ia'", "Ib'", and "Iaa'" (claim 3); and "Ihe'" (claim 60).

Claim 1 (2nd line following structural formula) is amended to correct an inadvertent typographical error, the amendment setting forth: "...A is C(=O)R¹ C(=O)OR¹..."; and supported, for example, by the specification, page 2, last line.

As explained in further detail below, Claim 1 is further amended to set forth: "...J, if present, is a single 3 to 10-membered saturated or partially unsaturated alkylene chain extending that extends from the R⁷/R⁷ cycloalkyl or from the carbon atom to which R⁷ is

~~attached to one of R_j, R_x, R_y or R¹¹ G to form and forms~~ a macrocycle, …”, the amendment supported, for example, by original claims 1, including formula I; and claim 60; specification pages 13-14; and EXAMPLES 128, 129, 139, and 140.

As explained in further detail below, Claim 1 is further amended as set forth above, in order to present the macrocyclic compounds comprehended by the claim as amended, and to correct minor inadvertent typographical errors. The scope of the claim is not extended beyond that which was included in the claim as originally filed, by way of this amendment. Therefore, the amendments are well-supported, for example, by the claim as originally filed and throughout the specification.

Claim 22 and 24 are amended as set forth above to correct minor inadvertent typographical errors.

Claim 25, claim line 2, is amended to delete the word “preferably”. The amendment is supported, for example, by claim 25 as originally filed.

As explained in further detail below, Claim 26 is further amended as set forth above, in order to present the Claim in independent form, to further incorporate the limitations of Claims 22 and 23 (with respect to position W), and to retain the scope of the limitations of original Claim 26 with respect to positions R⁹ and R¹⁰. Accordingly, the amended claim incorporates all the limitations of amended claim 1, with the exception of the limitations pertaining to positions R⁹ and R¹⁰, and further includes the limitations of Claims 22 and 23. Therefore, amended Claim 26 is supported, for example, by claims 1, 22, 23, and 26, as originally filed.

In light of the cancellation of Claim 2, Claim 45 is amended to depend on claim 1, as set forth above, and to correct a minor inadvertent typographical error. The amendment is supported, for example, by claims 1, 2, and 45 as originally filed.

Claim 60 is amended as set forth above, consistent with the amendment of claim 60, in order to set forth the designation of the structural formula “Ihe’”. Claim 60 is further amended to include the recitation “...said aryl or heteroaryl being optionally substituted with R¹⁰...”, in order to place the claim in condition for allowance. Support for this amendment can be found, for example, on page 18, lines 6-7, of the specification.

New Claim 69 is supported, for example, by page 28, lines 8-11.

New Claim 71 is supported, for example, by EXAMPLES 128, 129, 130, 131, 132, 139, and 140.

Reconsideration and Rejoinder

The Office Action indicates that claims 9-22, 25-41, 56-58, and 66-68 have been withdrawn from consideration as being drawn to a nonelected invention, there being no allowable generic or linking claim. Of these claims that are deemed withdrawn from consideration, claims 22, 25-41, and 66-68 will remain pending in the application upon entry of this amendment. As set forth above, and further explained in detail below, the claims have been amended to limit the claimed subject matter to a set of well-described macrocyclic compounds. Accordingly, Applicant respectfully submits that a coextensive search and examination of the entire pending claim set will not necessitate any undue burden on the Office, and such search and examination of the entire pending claim set upon entry of the present amendment is respectfully requested.

Furthermore, with respect to claims 25, 26, 27-33, and 35; Applicant further submits that, as the claims read on the elected species, they should be reconsidered and examined on the merits; and such reconsideration is respectfully submitted.

Alternatively, as Claims 22, and 25 have dependency on generic claim 1, claim 24 serving as a linking claim, it is respectfully submitted that upon allowance of claims 1 and/or 24, claim 25 be appropriately rejoined and included in the allowance; and notification as to such rejoinder is respectfully requested. Claim 26, as presently amended to independent form, is a generic claim to which claims 27-41 include dependency. Therefore, it is respectfully submitted that upon allowance of generic

claims 26 and/or one or more linking claims thereof (claims 27, 30, 31, 32, 33, and 38); claims 27-41 be appropriately rejoined. and included in the allowance; and notification as to such rejoinder is respectfully requested. Finally, Claims 66, 67, and 68 include dependency on claim 1; Claim 60 serving as a linking claim. Therefore, it is respectfully submitted that upon allowance of generic claims 1 and/or linking claim 60; claims 66, 67, and 68 be appropriately rejoined and included in the allowance; and notification as to such rejoinder is respectfully requested.

The Objections based on minor Informalities should be withdrawn

The Examiner is thanked for pointing out the minor informalities upon which present objection is based. Each of these objections set forth in paragraphs 2-5 of the Office Action is obviated by the amendments of Claims 1, 24 and 25 as set forth above.

The rejection under 35 USC §112, second paragraph should be withdrawn

The Office action indicates that claims 1-8, 23-24, 42-43, 45, 47-53, and 60-65 are rejected under 35 USC §112, second paragraph, for indefiniteness. With respect to the comments in paragraph 7 of the Office Action, this rejection is obviated by the amendment of Claim 1 as set forth above.

Paragraph 8 of the Office Action alleges that the definition of J is unclear. This rejection is respectfully traversed. Nevertheless, to facilitate prosecution and allowance of the present claims under consideration, Claim 1 is amended as stated above, to include the limitations “...J, if present, is a single 3 to 10-membered saturated or partially unsaturated alkylene chain extending that extends from the R⁷/R⁷ cycloalkyl or from the carbon atom to which R⁷ is attached to one of R_j, Rx, Ry or R^H G to form and forms a macrocycle which is optionally...”, “...G is -O-, -NRy-, -NRjNRj-, where one R_j is H and the other R_j is H, C₁-C₅ alkyl or J...”, and “...Ry is H, C₁-C₅ alkyl; or Ry is J;...”. Therefore, rejection of the claims under consideration is clearly obviated.

Paragraphs 9 and 10 of the Office Action indicate insufficient antecedent basis for the recitations of “the formula...” in lines 1 of claims 1 and 60. This rejection is obviated by deletion of the word “the” from line of each claim under consideration, as set forth above.

In light of all of the above, Applicants request that this rejection of the claims under consideration under 35 USC §112, second paragraph, be withdrawn.

The rejection under 35 USC §112, first paragraph, should be withdrawn

Paragraph 12 of the Office action indicates that claims 1-8, 23-24, 42-43, 45, 47-53, and 60-65 are rejected under 35 USC §112, first paragraph, for failing to comply with the written description requirement.

This rejection is respectfully traversed. Nevertheless, to facilitate prosecution and allowance of the present claims under consideration, independent Claims 1 and 26 are amended as stated above, to claim the clearly described group of macrocyclic compounds. More particularly, and as set forth in the preceding section, claim 1 is amended to include the limitation: “...J, if present, is a single 3 to 10-membered saturated or partially unsaturated alkylene chain extending that extends from the R⁷/R⁷ cycloalkyl or from the carbon atom to which R⁷ is attached to one of R_j, Rx, Ry or R¹¹ G to form and forms a macrocycle which is optionally...”, “...G is -O-, -NRy-, -NRjNRj; where one R_j is H and the other R_j is H, C₁-C₈ alkyl or J...”, and “...Ry is H, C₁-C₈ alkyl; or Ry is J;...”. Furthermore, the structural formulas presented in each of claims 1, 3, 26, and 60 are amended to further depict the stereochemistry of the indicated position set forth in the amended claims; consistent with the stereochemistry depicted on page 10 of the Office Action. Accordingly, independent Claims 1 and 26 are drawn to a well-described group of macrocyclic compounds, further sharing a common stereochemistry. The remaining variables are clearly described substitutions within, and around, the well-described macrocyclic structure. Furthermore, the description includes numerous members of representative species of the presently claimed macrocyclic compounds. See for example; EXAMPLES 128, 129, 139, and 140.

In light of all of the above, Applicants request that this rejection of the claims under consideration under 35 USC §112, first paragraph, be withdrawn.

The rejection under 35 USC §102(a), should be withdrawn

The Office action indicates that claims 1-8, 23-24, 42-43, 45, 47-53, and 60-65 are rejected under 35 USC §102(a), as being anticipated by Wu et al (US Patent No. 7,125,845); more specifically as set forth in paragraph 15 of the Office Action.

The claims under consideration are amended as set forth and explained above, in order to facilitate prosecution and allowance of the retained Claims. This rejection of the

claims under consideration is obviated by the above-explained amendments to independent Claims 1 and 26; the amended claims including the recitation:

“...J is a single 3 to 10-membered saturated or partially unsaturated alkylene chain that extends from the R⁷/R⁷ cycloalkyl to G and forms a macrocycle which is optionally...”, “...G is -NRy-, ...”, and “...Ry is J...”. In light of this amendment, and further in light of the substitutions set forth for position R¹⁶ of the present Claims 1 and 26; Applicant submits that all claims under consideration are free of anticipation by the Wu et al. reference.

In light of all of the above, Applicants request that this rejection of the claims under consideration under 35 USC §102(a), be withdrawn.

The rejection under 35 USC §102(e), should be withdrawn

The Office action indicates that claims 1-8, 23-24, 42-43, 45, 47-53, and 60-65 are rejected under 35 USC §102(e), as being anticipated by Wu et al (US Patent No. 7,125,845). For the reasons set forth in the preceding section directed to the rejection under 35 USC §1102(a), this rejection of the claims is obviated, and should be withdrawn.

In light of all of the above, Applicants request that this rejection of the claims under consideration under 35 USC §102(e), be withdrawn.

CONCLUSION

In light of all of the above Amendments and Remarks, Applicants submit that all the claims are now in condition for allowance, and a Notice informing the Applicant of such allowance is respectfully solicited.

Authorization for a two month extension fee under 37 C.F.R. 1.17(a)(2) is submitted herewith. It is not believed that any other fees are due with this response. However, in the event that there are any fees associated with the filing of this response, the commissioner is hereby authorized to charge the appropriate amount to Deposit Account number 12-2136.

Should the examiner have any questions regarding this submission, or in the event that a telephone interview may otherwise expedite the prosecution of this case, the examiner is invited to contact the undersigned at (734) 213-1029.

Respectfully submitted,

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